

Atty. Docket No.: VI/98-023.DE.PCT.US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KLAUS URICH

Serial No.: 09/763,646

Filed: July 9, 2001

**Title: SYRINGES AND INJECTORS
INCORPORATING MECHANICAL
FLUID AGITATION DEVICES**

Art Unit: 3763

Examiner: Catherine Serke

**PETITION UNDER 37 C.F.R §§ 1.181 AND 1.127
FROM REFUSAL TO ENTER AMENDMENT**

Attn: Technology Center Director – TC3700

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

Pursuant to 37 C.F.R. §§ 1.127 and 1.181, Applicant hereby petitions from the refusal set forth in the Advisory Action mailed on August 12, 2003, to enter certain amendments to Claims 1 and 34 filed pursuant to 37 C.F.R. § 1.116. Based on the statement of facts presented below, Applicant hereby requests entry of the amendments to Claims 1 and 34, and allowance of this application.

The Advisory Action refused to enter the amendments to Claims 1 and 34 because they would raise new issues that would require further consideration and/or search. In

Note 2, the Advisory Action explained:

[w]hile claims 1 and 34 were amended to include previously indicated allowable subject matter, functional language was

removed from the claim. The removal of the functional language changes the scope of the claim since in the previous rejection the prior art used was capable of being used in the function as claimed. While functional language in the preamble is given limited patentable weight, removal of the language does change the scope of the claim and even though indicated allowable subject matter was added the claims are subject to a new consideration/search.

Applicant submits that removal of the noted language from Claims 1 and 34 was based on the Examiner's numerous comments in the Final Action that the noted language (i.e., 'injector system,' 'movement mechanism,' 'control device' and other functional language) did not limit the claimed inventions and was not given patentable weight.

As set forth in the passages below, the Final Action stated numerous times that functional limitations, preamble limitations and non-positively-claimed limitations are not actual limitations on the inventions being claimed in Claims 1 and 34. In particular, the Final Action stated:

Regarding the functional language in the claims, as long as the prior art meets the structural limitations of the claims and is capable of performing the recited function then the prior art reads on the claims. . . . **The particulars of the injector system** [i.e., the 'movement mechanism,' 'injector system' and 'control device' language removed from the preamble and body of Claims 1 and 34] **is irrelevant since the injector system itself is not positively claimed.** (Page 2 of Final Action; emphasis added.)

In response to Applicant's argument, the recitation "for use with an injector system comprising a movement mechanism and a control device operably associated with the movement mechanism" **has not been given patentable weight because the recitation occurs in the preamble.** (Page 3 of Final Action; emphases added.)

Additionally, **applicant asserts that independent claims 1 and 34 require (1) an ultrasound contrast agent and (2) a control device operable to control the movement / rotation of the syringe induced by the movement mechanism This assertion is incorrect since these limitations are not positive limitations of the claims.** (Page 3 of Final Action; emphasis added.)

The invention of these claims [i.e., Claims 1 and 34] is the syringe and not the combination of a syringe with an injection system. . . . Therefore, the positively recited limitations in the body of the claim further define the syringe alone. The fact that the body of the claim further describes the control system that the syringe may be used with is irrelevant. These are not further limitations on the invention being claimed. (Page 4 of Final Action; emphasis added.)

In view of the clear statements above, Applicant submits that the explanation in the Advisory Action is inconsistent with and/or incorrect in view of the Final Action.

First, the removal of the noted language would not raise new issues, as stated in the Advisory Action, because the noted language was carefully considered in detail in the Final Action – with the Examiner concluding that the noted language did not limit the claimed inventions and was not given patentable weight.

In addition, because the Final Action stated that the ‘injector system’ and other functional language did not limit the claims and was not given patentable weight, it is unclear how “removal of the functional language changes the scope of the claim” as set forth in the Advisory Action. The noted functional language either does not affect the scope of the claims (as set forth in the Final Action) or it does affect the scope of the claims (as set forth in the Advisory Action) - the Office cannot take both positions and remain consistent. If the Office maintains the decision in the Advisory Action, then the ‘injector system’ and other functional language previously in Claims 1 and 34 should have been considered to distinguish over the prior art, and the analysis in the Final Action is therefore flawed.

Further, Applicant submits that the numerous statements in the Final Action (i.e., indicating that the ‘injector system,’ ‘movement mechanism,’ ‘control device’ and other

functional language did not limit the claimed inventions and was not given patentable weight) provide a clear indication that the noted claim language was irrelevant from a patentability standpoint. As such, Applicant's removal of the noted language from Claims 1 and 34 should have only required a cursory review by the Examiner and was, in fact, based on the Examiner's explicit statements in the Final Action.

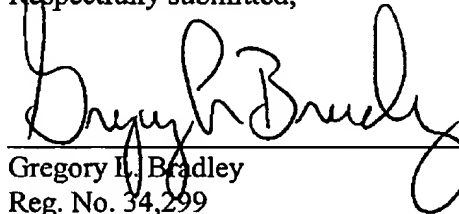
Even though patent applicants cannot, as a matter of right, amend finally rejected claims, Applicant submits that the MPEP supports the entry of the amendments to Claims 1 and 34 in this application. Specifically, the MPEP states:

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirements of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. MPEP §714.13, pg. 700-204 (Rev. 1, Feb. 2003) (emphasis added).

Consequently, Applicant submits that removal of the noted language from Claims 1 and 34 does not raise new issues for the Examiner. Entry of the amendments to Claims 1 and 34 and allowance of this application is respectfully requested.

If a fee is required for consideration of this Petition, the Commissioner is hereby authorized to charge the requisite fee to Deposit Account No. 13-2530.

Respectfully submitted,



Gregory L. Bradley
Reg. No. 34,299

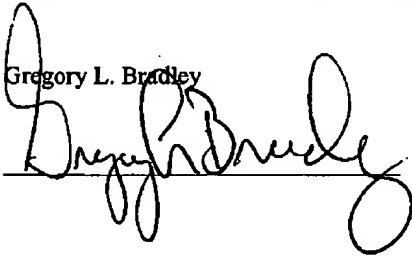
Dated: September 10, 2003

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Re: Petition under 37 C.F.R. 1.181 and 1.127 for Application Serial No. 09/763,646